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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,950	04/06/2001	Galo F. Acosta	2599-103-D2	8081

6449 7590 05/20/2004

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EXAMINER
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CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

cf

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/826,950	ACOSTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	LaToya I. Cross	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-33 and 39-52 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 26-33, 40-42 and 44-48 is/are rejected.  
 7) ☒ Claim(s) 38, 39, 43 and 49-52 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

This Office Action is in response to Applicant's amendments filed on February 6, 2004. Claims 26-33 and 39-52 are pending.

#### *Withdrawal of Rejections from Previous Office Action*

- The obviousness rejection over Mack in view of Astle is withdrawn in view of Applicants' amendments to recite "fixed" first and second receiving structures.

#### *Claim Rejections - 35 USC § 103*

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 26-33, 40-42, 44-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,554,839 to Hewett et al.

Hewett et al disclose an apparatus for transferring liquids for filling or diluting microliter quantities of reagents for bioassays. The apparatus comprises a tray (12) for holding a plurality of receptacles (wells 34), similar to Applicant's first receiving structures. The apparatus further includes a rack (14) for pipette tips (30), similar to Applicant's second receiving structure. The tips are contamination limiting elements. Hewett et al further disclose a pipette assembly (24) that engages the pipette tips and allows fluid flowing from pump (36) to be delivered to receptacles (34). The pipette assembly is similar to Applicants' claimed substance transfer device in that it engages the pipette tips and positions the tips, containing reagents or fluids, with respect to the receptacles to transfer fluid thereto. With respect to the simultaneous engaging of the

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pipette tips and simultaneous dispensing of liquids, Hewett et al disclose that pipette assembly comprises a row of pipettes that engage the rows of pipette tips and are moved together, as one unit, to the receptacles (34) to dispense fluids.

Hewett et al differ from the instantly claimed invention in that table on which the pipette tip rack and receptacle tray moves on bed (10). However, both the pipette tip rack and receptacle tray are fixed onto the bed. With respect to the substance transfer device being operated manually, such is considered to be functional language, which does not patentably limit the claims. See MPEP 2114. Even if, however, such would be considered to limit the claims structurally, it would have been obvious to one of ordinary skill in the art to have the apparatus of Hewett to operate manually as a "backup" to its automatic operation in the event of mechanical failure. This would increase the lifespan of the device and possibly eliminate costly repairs due to mechanical breakdown.

#### ***Allowable Subject Matter***

3. Claims 38, 39, 43, 49-52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to the above mentioned claims, the prior art of record fail to teach or suggest a registration structure associated with the first and second receiving structures (claims 38, 39), one or more cassettes for the contamination limiting elements having contamination limiting element receiving tubes (claim 43), the structure of the substance transfer device as recited in claims 49 and 50 and magnetic structures as recited in claims 51 and 52.

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4. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
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